

Notice of Allowability

Application No.

10/681,578

Examiner

Michael P. Barker

Applicant(s)

LEARMONTH ET AL

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/22/06.
2. ☒ The allowed claim(s) is/are 1-4;6;8;14-26.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. ☐ Notice of References Cited (PTO-892) | 5. ☐ Notice of Informal Patent Application (PTO-152) |
| 2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. ☐ Examiner's Amendment/Comment |
| 4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. ☒ Examiner's Statement of Reasons for Allowance |
| | 9. ☐ Other _____. |

Art Unit: 1626

DETAILED ACTION

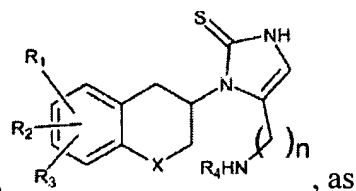
Applicant cancelled **Claims 5, 7, and 9-13**; amended **Claims 2, 6, and 8**; and added **Claims 14-26**. Therefore, **Claims 1-4, 6, 8, and 14-26** are currently pending in this application. Furthermore, **Claims 1-4, 6, 8, and 14-26** are allowed.

Information Disclosure Statement

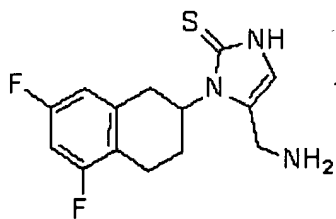
Applicant's information disclosure statement (IDS), submitted July 27, 2004, has been considered. However, as the IDS was not submitted as PTO-1449, a copy is not being submitted with this Office Action.

Reasons for Allowance

Applicant's amendments filed May 22, 2006 obviate the rejections and objections previously put forth. Therefore, the rejections and objections put forth in the previous Office Action are withdrawn.



Applicant's invention is drawn to compounds of Formula I, as well as a process for preparing the compounds of Formula I and a method for using the compounds of Formula I. The closest prior art to Applicant's claimed invention is disclosed in U.S. Patent No. 5,538,988, issued July 23, 1996. The '988 patent discloses the following



compound:

[col. 99, Claim 8]. Applicant avoids the prior art taught

by the '988 patent via a proviso which deletes the possibility of Applicant's Formula I forming

Art Unit: 1626

the disclosed compound. Namely, Applicant carves out of the claimed invention the subgenus of compounds which result when n is 1 and X is CH_2 . Ordinarily, such a proviso would not obviate the need for an obviousness rejection under 35 U.S.C. 103(a). However, in this instance, the '988 patent does not disclose Markush language encompassing any of Applicant's claimed invention. Instead, the '988 patent is specifically limited to an aminomethyl in the 5-position of the imidazole ring and does not disclose, for instance, broader language which would include, say, an aminoethyl or aminopropyl. Thus, without such broad language, there is no corresponding motivation to the person of ordinary skill in the art to expect the would-be obvious compounds of Applicant's claimed invention would also be successful. Therefore, the compounds of Formula I, the process of making, and the methods of using those compounds are allowed.

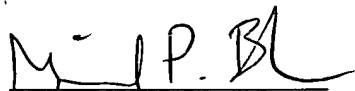
Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Barker whose telephone number is (571) 272-4341. The examiner can normally be reached on Monday-Friday 8:00 AM- 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699. The unofficial fax phone for this group are (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is viable through Private PAIR only. For more information about the PAIR system,

Art Unit: 1626

see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael P. Barker
Patent Examiner, AU 1626

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER



(for) Joseph McKane
Supervisory Patent Examiner, AU 1626